

### REMARKS

Applicants thank the Examiner for consideration given the present application. Claims 1 and 3-5 are presently pending. Claims 2 and 6 are canceled. Claim 4 has been amended. Claims 1, 3 and 5 are independent. Applicants respectfully request reconsideration of the rejected claims in light of the amendment and remarks presented herein, and earnestly seek timely allowance of all pending claims.

#### Claim Rejections Under 35 U.S.C. § 112, second paragraph

Claims 4 and 6 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants thank the Examiner for pointing out these errors. In light of the amendment to claim 4 and the cancellation of claim 6, Applicants respectfully request that the rejection be withdrawn.

#### Claim Rejections Under 35 U.S.C. § 102(b) – Beale

Claims 1 and 3-5 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Beale (“Beale”, U.S. 4,945,726). This rejection is respectfully traversed.

Independent claims 1 and 3 recite, *inter alia*, “**wherein the rod is formed in a shape of a hollow pipe, and is fitted with, at one end thereof, a member for minimizing flow of the working gas between the back-pressure space and the hollow space**”. Independent claim 5 recites, *inter alia*, “**wherein there is provided, in a part of the hollow space inside the rod located away from the outlet with respect to the displacer piston, means for preventing the working gas from flowing between the work space and the back-pressure space**”. Beale does not disclose the above-mentioned claim features. The Office Action simply points to several elements, 217, 218, 214, 216, and 212 to disclosed this member, however these elements of Figure 8 simply a cross bar 217, spring 218, longitudinal passage 214, annular groove 216, and sliding spool valve 212. There is not even the mere mention of “wherein the rod is formed

in a shape of a hollow pipe, and is fitted with, at one end thereof, a member for minimizing flow of the working gas between the back-pressure space and the hollow space” as recited by independent claims 1 and 3 nor “wherein there is provided, in a part of the hollow space inside the rod located away from the outlet with respect to the displacer piston, means for preventing the working gas from flowing between the work space and the back-pressure space” as recited by independent claim 5.

Independent claims 1, 3 and 5 recite, *inter alia*, **“wherein the pressure container comprises: a work space located on a displacer piston side of the power piston; and a back-pressure space located on a side of the power piston opposite to the work space.”** The Office Action fails to provide a reference for this feature of the claimed invention. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Examiner has failed to identify where such feature is found in the reference.

Independent claim 3 recites, *inter alia*, **“wherein the inlet is formed in a wall surface to which the rod is connected, the inlet penetrating the wall surface from outside the wall surface into the hollow space, wherein the outlet is formed in a side circumferential wall of the displacer piston, the outlet penetrating the side circumferential wall from the hollow space to outside an outer circumferential surface of the displacer piston”**. The Office Action fails to identify where this feature of the claimed invention is found in the reference. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). There has been no reference applied to the above-mentioned claim feature. Further, the prior art of record fails to disclose the above-mentioned claim feature.

Additionally, the Examiner has also failed to identify where the following claim features are found in the prior art that has been applied:

- Independent claim 5 recites, *inter alia*, “**wherein the inlet is formed in a wall surface to which the rod is connected, the inlet penetrating the wall surface from outside the wall into the hollow space, wherein the outlet is formed so as to penetrate the displacer piston from the hollow space inside the displacer piston to outside an outer circumferential surface thereof**”.
- Independent claim 5, recites, *inter alia*, “**wherein there is provided, in a circumferential side wall of a part of the rod inserted in the slide hole, one or more than one gas outlet formed and penetrate, in a direction of a radius of the rod, the circumferential side wall from the hollow space to outside an outer circumferential surface thereof**”.

For at least the reasons stated above, independent claims 1, 3 and 5 are patentably distinct from Beale. Claims 4 and 6 are at least allowable by virtue of their dependency on corresponding allowable independent claim.

Accordingly, it is respectfully requested to withdraw this anticipation rejection of claims 1 and 3-6 based on Beale.

#### Claim Rejections Under 35 U.S.C. § 102(b) – Beale

Claim 5 stands rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Beale (“Beale”, U.S. 4,404,802). This rejection is respectfully traversed.

Independent claim 5 recites, *inter alia*, “**wherein the displacer piston has formed therein: one or more than one inlet via which the working gas flows into the hollow space inside the piston; and one or more than one outlet via which the gas having flowed into the hollow space flows out of the hollow space**”. The Office Action fails to provide a reference for this feature of the claimed invention. “A claim is anticipated only if each and every element as

set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). There has been no reference applied to the above-mentioned claim feature. Further, the prior art of record fails to disclose the above-mentioned claim feature.

Additionally, the Examiner has also failed to identify where the following claim features are found in the prior art that has been applied:

- Independent claim 5 recites, *inter alia*, “**wherein the inlet is formed in a wall surface to which the rod is connected, the inlet penetrating the wall surface from outside the wall into the hollow space**”.
- Independent claim 5 recites, *inter alia*, “**wherein the outlet is formed so as to penetrate the displacer piston from the hollow space inside the displacer piston to outside an outer circumferential surface thereof**”.
- Independent claim 5 recites, *inter alia*, “**wherein there is provided, in a part of the hollow space inside the rod located away from the outlet with respect to the displacer piston, means for preventing the working gas from flowing between the work space and the back-pressure space**”.
- Independent claim 5 recites, *inter alia*, “**wherein there is provided, in a circumferential side wall of a part of the rod inserted in the slide hole, one or more than one gas outlet formed and penetrate, in a direction of a radius of the rod, the circumferential side wall from the hollow space to outside an outer circumferential surface thereof**”.

For at least the reasons stated above, independent claim 5 is patentably distinct from Beale.

Accordingly, it is respectfully requested to withdraw this anticipation rejection of claims 5 based on Beale.

Conclusion

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Charles Gorenstein, Reg. No. 29,271 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

By 

Charles Gorenstein

Registration No.: 29,271

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant